

R E M A R K S

I. Introduction

Claims 1-67 are pending in the application. All pending claims stand rejected under 35 U.S.C. §103(a) as unpatentable over U.S. Patent No. 6,078,663 (hereinafter "Yamamoto") in view of U.S. Patent No. 5,508,817 (hereinafter "Kunigami"), in further view of U.S. Patent No. 6,625,652 (hereinafter "Miller"). Applicants respectfully incorporate herein all arguments and traversals set forth in the three previous responses submitted to the Examiner in relation to prosecution of the current application.

Upon entry of this amendment, which is respectfully requested, claims 3, 33, and 52 will be cancelled without prejudice or disclaimer, and claims 1, 18-24, 31, 38, 40, 46-50, 57, 59, and 65-66 will be amended. No new matter is believed added by this amendment. Support for all amendments exists in the specification and claims as originally filed, and all such matter has previously been searched by the Examiner.

Applicants respectfully request reconsideration and allowance of the pending claims in view of the arguments presented herein (including those incorporated by reference) and in accordance with 37 CFR §1.112.

II. Preliminary Matters

The Yamamoto reference has been relied upon by the Examiner as a reference in each of the four Office Actions in this case. Applicants have traversed the Examiner's rejection in three prior responses, and the Examiner has failed to respond to Applicant's arguments. Applicants respectfully request, once again, that the Examiner "take note of the applicant's argument[s] and answer the substance of [them]" as required by MPEP §707.07(f). Applicants further note that the Examiner's continued reliance upon a reference that fails to teach claimed embodiments and refusal to address the Applicants' arguments is an improper and unnecessary delay in prosecution in contravention to 37 C.F.R. §1.104 and MPEP §707.02.

III. The Examiner's Rejection

Claims 1-67 stand rejected under 35 U.S.C. §103(a) as unpatentable over Yamamoto in view of Kunigami, in further view of Miller. Applicants respectfully traverse this ground of

rejection. In an attempt to articulate some of the fundamental differences between the claims and the cited references, Applicants set forth below an illustrative example.

A. Illustrative Example

Some fundamental differences between claimed embodiments and the cited references may be understood by following a hypothetical user's actions on the Internet. This example is provided solely for illustration.

In our example, a consumer uses a computer with Internet access to visit various Websites. In particular, the consumer visits the website of a prominent newspaper to see the daily headlines or read an electronic version of the paper. If the user desires to download newspaper information or view an article online, the features of the **Yamamoto** reference could provide a mechanism for determining a fee to charge the consumer for receiving such information. In other words, the consumer solicits the information from the newspaper provider and agrees to pay a fee for the solicited information.

The consumer then visits a corporate website to request product information. Features of the **Kunigami** reference could be used by the Website to provide a mechanism for dividing the cost of transmitting the information between the consumer and the corporation, based on rules established by the corporation (*i.e.*, rules designed to recuperate costs associated with providing the information to the consumer). In other words, the corporation may use features of Kunigami to charge the consumer a portion of any transmittal fee associated with the information solicited by the consumer.

Meanwhile, the consumer's computer (a client host) can be configured to listen for network messages, in accordance with **Miller**, on a "well known" multi-cast group network address. If the "well known" address is a "public address", then the consumer's computer may join the group at will. If the "well known" address is a "private address", then the consumer's computer must have permission to join the group to listen for messages at that address. In other words, features of the Miller system act to bar the potential recipient (the consumer) from listening to the "private address". The sender (typically a server that sends information to the "well known" address) is not barred from sending to the so-called "private address", and is necessarily always privy to the address.

The consumer may then operate his computer to check e-mail by visiting the consumer's Internet service provider (ISP) website or by using a standard e-mail software package. Opening his in-box, he sees several new messages. A first message is from the ISP and indicates that an unsolicited e-mail has been sent to the consumer's *public e-mail address* (e.g., consumer@isp.com). The consumer is then presented with an option, in accordance with **currently claimed embodiments**, of whether or not to charge the sender for allowing the unsolicited e-mail to be forwarded to the consumer's *private e-mail address* (e.g., not-consumer@isp.com, consumer@not-ispl.com, etc.). If the sender refuses to pay the consumer-designated fee or if the consumer so desires, the unsolicited e-mail is either deleted or returned to the sender, without ever having reached the consumer's *private e-mail address*. Further, the sender is never privy to the consumer's *private e-mail address*. In this manner, the consumer's *private e-mail address* is protected and the consumer can selectively permit (for a fee) messages to be forwarded.

B. The references fail to teach or suggest *means for monitoring information sent by a sender and asynchronously received at a public fee address associated with an e-mail recipient, wherein the information is unsolicited by the e-mail recipient*

Applicants respectfully assert that neither Yamamoto, Kunigami, nor Miller, either alone or in any combination, teach, suggest, or render obvious embodiments as described in claims 1-67. For example, none of the references teach or suggest *means for monitoring information sent by a sender and asynchronously received at a public fee address associated with an e-mail recipient, wherein the information is unsolicited by the e-mail recipient* (a limitation generally included in each of the claims).

Applicants have added the limitation of *unsolicited information* to further clarify distinctions between the claimed embodiments and the cited references. As is shown in the example above, the information described in each of the cited references is information solicited by a recipient. In other words, a recipient requests a newspaper article or other information from an information provider (such as in Yamamoto or Kunigami), or the recipient subscribes to a network service to receive network messages and information (as in Miller). This is in direct contrast to currently claimed embodiments in which information is unsolicited. For example, none of the cited references describe receiving unsolicited e-mails (junk mail, SPAM, etc.). In

contrast, current embodiments allow for the "dramatic[] cut down on the amount of junk mail received". (Pg. 2, lines 10-11).

Thus, Applicants respectfully assert that Yamamoto, Kunigami, and Miller, either alone or in combination, fail to anticipate (or render obvious) embodiments as recited claims 1-67, at least because the cited references fail to teach or suggest *means for monitoring information sent by a sender and asynchronously received at a public fee address associated with an e-mail recipient, wherein the information is unsolicited by the e-mail recipient.*

C. The references fail to teach or suggest *means for determining a fee for the information, wherein the fee is based upon a preferences record defined by the e-mail recipient*

Applicants respectfully assert that neither Yamamoto, Kunigami, nor Miller, either alone or in any combination, teach, suggest, or render obvious embodiments as described in claims 1-67. For example, none of the references teach or suggest *means for determining a fee for the information, wherein the fee is based upon a preferences record defined by the e-mail recipient* (a limitation generally included in each of the claims).

As described in the previous responses and as illustrated in the example above, Yamamoto fails to teach or suggest such an embodiment. Instead, Yamamoto describes determining a fee based on the *sender's* preferences. This works well in Yamamoto since the sender of valuable information expects to receive payment (as in the news website example above) for sending this solicited information to the recipient.

If Yamamoto were to allow the recipient to designate the fee, the newspaper would never make money because every recipient would choose not to pay for the articles. This would frustrate the purpose of the Yamamoto reference.

Thus, Applicants respectfully assert that Yamamoto fails to anticipate (or render obvious) embodiments as recited claims 1-67, at least because Yamamoto fails to teach or suggest *means for determining a fee for the information, wherein the fee is based upon a preferences record defined by the e-mail recipient.*

Applicants further respectfully assert that Kunigami fails to make up for the deficiencies of Yamamoto. As described in the previous responses and as illustrated in the example above, Kunigami describes splitting transaction fees between the sender and the recipient based on the

sender's preferences. This works well in Kunigami because the recipient has sought out the sender and has chosen to receive (*i.e.*, has solicited) the sender's material and further has accepted the obligation to pay part of the transmission costs as defined by the sender.

If Kunigami were to allow the recipient to determine the fee, the sender would never get paid for the transmitted materials (recipients would always opt not to pay). In other words, the consumer can not appropriately determine a fee for information solicited by the consumer himself.

Applicants therefore respectfully assert that Kunigami fails to anticipate (or render obvious) embodiments as recited in claims 1-67, at least because Kunigami fails to teach or suggest *means for determining a fee for the information, wherein the fee is based upon a preferences record defined by the e-mail recipient.*

Applicants further respectfully assert that Miller fails to make up for the deficiencies of Yamamoto and Kunigami. The newly-cited Miller reference is simply not directed to a fee-structured system. Miller describes a computer network with servers and client hosts where multi-cast and broadcast network messages are sent and received using a method that "prunes" host lists. Nowhere in Miller are e-mail recipients, fees, or fees determined by e-mail recipients described, taught, or suggested.

Applicants therefore respectfully assert that Miller fails to anticipate (or render obvious) embodiments as recited in claims 1-67, at least because Miller fails to teach or suggest *means for determining a fee for the information, wherein the fee is based upon a preferences record defined by the e-mail recipient.*

Accordingly, Applicants respectfully assert that no combination of the cited references teaches, or suggests embodiments of claims 1-67.

Further, Applicants respectfully assert that there is simply no motivation in any reference to modify any other reference to provide the claimed feature of *means for determining a fee for the information, wherein the fee is based upon a preferences record defined by the e-mail recipient.* Applicants therefore respectfully request that the §103(a) rejections of claims 1-67, be withdrawn.

D. The references fail to teach or suggest *means for forwarding the information received at the public fee address to a private e-mail address associated with the e-mail recipient*

Applicants respectfully assert that neither Yamamoto, Kunigami, nor Miller, either alone or in any combination, teach, suggest, or render obvious embodiments as described in claims 1-67. For example, none of the references teach or suggest *means for forwarding the information received at the public fee address to a private e-mail address associated with the e-mail recipient* (a limitation generally included in each of the claims).

The Examiner states that "[t]he combination of Yamamoto and Kunigami fails to teach and inventive concept of means for forwarding the information from a public address to a private address". (Paper No. 5, pg. 2, lines 11-12). Applicants agree with the Examiner's statement. The Examiner goes on to state however, that "[Miller] teach an inventive concept with means for forwarding the information from a public address to a private address (*see abstract, column 2 line 59-3 line 50, 4 lines 56-5 line 7*)". (Paper No. 5, pg. 2, lines 12-14). Applicants respectfully assert that the Examiner has mischaracterized the teachings of Miller. Nowhere does Miller teach, suggest, or render obvious *means for forwarding the information received at the public fee address to a private e-mail address associated with the e-mail recipient*.

Applicants respectfully assert that Miller fails to make up for the deficiencies of Yamamoto and Kunigami. While Miller does use the terms "public address" and "private address", (Col. 4, line 56 to Col. 5, line 7), the terms are defined and used completely differently than those terms as described by currently claimed embodiments. For example, Miller describes sending a broadcast message to a "well known" address. (*Id.*). The "well known" address in Miller is *known to all* senders and recipients. (*Id.*). In some cases, the "well known" address is a "private address", meaning that in order for a recipient to listen for messages arriving at the address, the *recipient* must have permission. (Col. 5, lines 3-7). In other words, the "private address" of Miller is *known to all*, but is *only accessible to a subset of recipients*. The "private address" of Miller is therefore not a private (*i.e.*, secret, at least with respect to the sender) address associated with a recipient, as described by currently claimed embodiments.

Further, none of the addresses described in Miller are e-mail addresses. Instead, the Miller addresses are network addresses associated with computer inter-communications (*e.g.*,

back-end device communications). Nor are any of the addresses associated with a particular e-mail recipient. Instead, the Miller addresses are associated with a sender. (Col. 4, lines 20-41; Col. 4, line 56 to Col. 5, line 7). Nor are any of the recipients in Miller e-mail recipients. Instead, they are client host computers. (Col. 4, lines 60-62).

Applicants therefore respectfully assert that Miller fails to anticipate (or render obvious) embodiments as recited in claims 1-67, at least because Miller fails to teach or suggest *means for forwarding the information received at the public fee address to a private e-mail address associated with the e-mail recipient.*

Accordingly, Applicants respectfully assert that no combination of the cited references teaches, or suggests embodiments of claims 1-67.

Further, Applicants respectfully assert that there is simply no motivation in any reference to modify any other reference to provide the claimed feature of *means for forwarding the information received at the public fee address to a private e-mail address associated with the e-mail recipient.* Applicants therefore respectfully request that the §103(a) rejections of claims 1-67, be withdrawn.

E. The Examiner has failed to establish a *prima facie* case for obviousness

Applicants respectfully suggest that the Examiner has not met the *prima facie* burden of obviousness for the pending claims because the Examiner has not pointed to a specific teaching or suggestion *in the prior art* but has merely provided an unsupported conclusory statement. The Examiner's statement that it would have been obvious to modify the prior art to "modify the combination of Yamamoto and Kunigami to include the inventive concept of Miller" because "this would have enhance the flexibility of the system" is not sufficient to meet the Examiner's burden of providing a *prima facie* case of obviousness.

The Examiner's conclusory statement offers no viable motivation or suggestion to combine. Applicants have reviewed all the references and have been unable to locate any motivation or suggestion in any reference that would have led one skilled in the art, at the time of invention, to combine any of Yamamoto, Kunigami, and Miller. Further, even if any of the references could be combined, the combinations suggested by the Examiner would still fail to teach or suggest elements of embodiments as claimed (as described herein).

"Whether the [Examiner] relies on an express or an implicit showing, [he/she] must provide particular findings thereto. Broad conclusory statements standing alone are not 'evidence'." In re Kotzab, 217 F.3d 1365, 55 U.S.P.Q.2d (BNA) 1313 (Fed. Cir. 2000), at 1370. Applicants therefore respectfully request that the Examiner provide any appropriate evidence that may support the Examiner's conclusions regarding motivation to combine.

IV. Conclusion

Accordingly, Applicants respectfully assert that each of the claims is patentable over the cited references, alone or in combination. Applicants therefore respectfully request that the Examiner's rejection of the pending claims be withdrawn. In view of the above, all pending claims are believed patentable over the cited references. Applicants respectfully request allowance of all pending claims. Applicants' silence with respect to other comments made in the Office Action does not imply agreement with those comments. If any issues remain, or if the Examiner has any further suggestions for expediting allowance of the present application, the Examiner is kindly invited to contact the undersigned via telephone at 203-972-4982.

Respectfully submitted,

January 6, 2004

Date

Carson C.K. Fincham
Carson C.K. Fincham
Registration No. 54,096
Buckley, Maschoff, Talwalkar & Allison LLC
Five Elm Street
New Canaan, CT 06840